

### REMARKS/ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

Claims 1-13 are pending. Upon entry of this amendment, claims 7 and 8 are canceled and claims 12 and 13 are withdrawn. Applicant reserves the right to pursue all non-elected subject matter in subsequent applications.

Claims 1-6 and 9-11 are amended and claims 14-26 are newly submitted herewith. It is believed that all claim amendments and newly submitted claims are adequately supported by the specification and do not add new matter. It is respectfully urged that the claims are now in proper form in all respects. Reconsideration and removal of the rejection is therefore proper and earnestly solicited.

Amended claims 1-6 and 9 are now drawn to embodiments of a cosmetic composition comprising the extract of *Cercis chinensis* and one or more additional ingredients selected from among oily components, thickeners, surfactant and higher alcohols. The oily component is further selected from among vegetable oil, mineral oil, silicon oil and synthetic oil. Explicit support in the specification for the composition claims may be found on page 24, line 14 up to the bottom of page 25, as well as several embodiments beginning on page 73. Claims 10-11 are directed to pharmaceutical compositions, which are supported, inter alia, at pp. 78-80 of the specification. Newly added claims 14-19 drawn to the method of protecting skin are similarly supported by the specification.

Examiner's comments are addressed below.

#### Rejections Under 35 USC § 102(b)

Examiner rejects claims 1, 2, 7 and 10 as allegedly being anticipated either Ma et al., or Li, et al. Examiner asserts that both Ma and Li teach extraction of *Cercis chinensis* with ethanol.

In addition, Examiner rejects claims 1, 2, 5, 7, 8 and 10 as allegedly being anticipated by Kim et al., who teaches extraction of *Cercis chinensis* with methanol wherein the extract contains myricitin and gallic acid.

Although not in agreement with the basis of each rejection, Applicants have amended independent claim 1 to recite that the cosmetic composition contains an extract of *Cercis chinensis*, and one or more components selected from among oils, a thickeners, surfactants and higher alcohols. Further, claim 1 indicates that the oil is selected from among vegetable oil, mineral oil, silicon oil and synthetic oil. It is respectfully submitted that these amendments are sufficient to distinguish claims 1-6 and 9 from either of Ma, Li or Kim.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. Neither of Ma, Li or Kim disclose a cosmetic composition comprising an extract of *Cercis chinensis* in addition to the other recited added ingredients. Accordingly, each reference fails to teach each claim limitation as required to make out a *prima facie* case of anticipation under § 102(b). It respectfully suggested that this rejection is traversed and should be withdrawn.

Similarly, claim 10 is not anticipated by Ma, Li or Kim. Neither discloses any pharmaceutical composition, let alone the one defined in amended claim 10. Ma and Li purify anthocyanin, a red pigment to study its metabolic stability. Kim describes an extract with six identified compounds, whereas Applicant has identified at least twenty, indicating that the extracts are not identical. Accordingly, it is respectfully submitted that the rejection of claim 10 be withdrawn.

Rejections Under 35 USC § 103(a)

The three rejections under § 103(a) follow below.

I. Claims 1, 2, 5-8, 10, 11 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over CN 1294926 in view of Kim et al. and further in view of JP 61200922 and ingenta connect. Examiner asserts that:

1. CN teaches that Chinese redbud (same as *Cercis chinensis*) is used to treat angina pectoris and is in capsule form, see abstract.

2. CN does not teach that the extract is in tablet form, that is extracted with ethanol or methanol or that *Cercis chinensis* inherently has piceatannol, myricitrin and gallic acid in it.

3. Kim teaches what is above.

4. Jp teaches that tablets and capsules are common alternates for different forms of a plant extract to be administered in, see abstract.

5. Ingenta connect teaches that piceatannol is in the *Cercis chinensis* extract inherently, see abstract.

Applicants respectfully disagree that the combination of these teachings and suggestions are sufficient to raise or maintain a *prima facie* case of obviousness.

As described above, neither Ma, Li or Kim disclose or suggest a cosmetic composition. Further CN discloses an orally administered composition for angina pectoris, wherein *Cercis chinensis* extract is the main ingredient. However, CN indicates that there are twelve additional actives in this disclosed composition; dried Chinese redbud bark and "...ginseng, red sage, myrrh, reticulate milettia and other eight [sic] Chinese medicinal materials...." Thus, the term "main ingredient" is without meaning. Is it the single most abundant additive? Is it 10% while the others are 1-8%? Is it present in an amount greater than the other 12 components combined? Thus, it is impossible to determine what CN's composition is, which renders the rejection inadequately supported by the reference.

That being said, it is respectfully submitted that CN's composition is incongruent with Applicants' disclosed and claimed subject matter. The office action fails to describe how the

composition comprising Chinese redbud bark plus 12 other actives can render obvious a cosmetic composition employing only one active component – *Cercis chinensis*. It is respectfully submitted that the cited references taken individually or in combination do not provide a conceptual nexus linking any cited *Cercis chinensis* extract to a cosmetic composition suitable for protecting skin against oxidative damage, wherein the composition comprises (a) *Cercis chinensis* (as the active ingredient) and (b) the additional recited components.

Further, it is respectfully suggested that Examiner's proposed combination of references would require that the CN composition be reduced to only *Cercis chinensis*, thus requiring removal of the 12 other active ingredients. However, doing so is likely to render the CN reference unsuitable for its intended purpose, i.e., treating angina pectoris. See MPEP 2143.01, stating "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Specifically, for the instant rejection to rise to *prima facie* obviousness, Examiner would have to provide evidence or scientific reasoning that establishes that removal of the other twelve active components from the CN composition would still provide a composition suitable for treating angina pectoris. Accordingly, the rejection of amended claims 1-2, 5-8 and 10-11, should be withdrawn.

II. Claims 1, 2, 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1347705 in view of Kim et al. and further in view of JP 07138175 and ingenta connect.

1. CN teaches that Chinese redbud (same as *cercis chinensis*) is used as a medicinal liquid and is in liquid form, see abstract.

2. CN does not teach that the extract is in powder or tablet form, that is extracted with ethanol or methanol or that *cercis chinensis* inherently has piceatannol, myricitrin and gallic acid in it.

3. Kim teaches what is above.

4 Jp teaches that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in, see. abstract.

5. Ingenta connect teaches that piceatannol is in the *Cercis chinensis* extract inherently, see abstract.

Based on these references Examiner concludes that it would have been obvious to extract *Cercis chinensis* with methanol since Kim makes it clear that the plant is commonly extracted with methanol and phenolic compounds can be isolated therefrom. Further it is allegedly obvious to use tablet or powder form instead of liquid form of CN since JP makes it clear that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered. Ingenta connect simply makes it clear that piceatannol is also inherently in *Cercis chinensis*.

In response it is respectfully suggested that the combination of references is not sufficient to make out a case of *prima facie* obviousness.

CN describes an herbal liquid prepared by boiling in water (i.e. decoction) at least three active herbal raw materials. There is no evidence or sound reasoning provided to suggest that CN's boiled aqueous extract of the three or more plant materials would even be remotely similar to that of Applicants' extract used in its compositions. Further, there is no disclosure indicating that CN's liquid composition has application as a cosmetic for anti-aging, anti-wrinkling due free radical damage. The CN composition is specifically formulated for treating piles, i.e., hemorrhoids, which are not cosmetic and not caused by free radical damage to the epidermis.

Further, Ma teaches ethanol extraction to yield a concentrated composition comprising anthocyanin. It is likely that this is almost a pure preparation in view of the goals stated in the abstract – studying anthocyanin. Thus, persons of ordinary skill in the art would not expect Ma's composition to be suitable for Applicants' intended purpose. Although Examiner repeatedly treats all extracts as inherently identical, there is no evidence to support that purified anthocyanin can substitute for the multicomponent composition disclosed and claimed herein. Further, in view of the claimed composition's purpose, it is unclear how Ma, Li or Kim would suggest a cosmetic for anti-aging, anti-wrinkling due free radical damage.

JP does not cure these deficiencies. In fact, JP specifically indicates that in its preparation "phenol substance is efficiently eliminated." Thus, the JP composition "can be administered over a long period of time safely without causing taste problem." Thus, JP clearly teaches away from Kim who explicitly discloses the various phenolic compounds in his methanolic extract. Thus, the rejection should be withdrawn as it is improper to combine Kim with JP. See MPEP 2145, stating "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)." It is respectfully suggested that this also applies to this rejection.

In conclusion, the rejection under § 103(a) over the combined teachings of CN 1347705 in view of Ma et al., Kim et al., and further in view of JP 07138175 should be withdrawn.

III. Claims 1-4, 7, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1347705 in view of Ma et al. and further in view of JP 07138175.

1. CN teaches that Chinese redbud (same as *Cercis chinensis*) is used as a medicinal liquid and is in liquid form, see abstract.

1. CN does not teach that the extract is in powder or tablet form or that is extracted with 60 % ethanol.

1. Ma teaches what is above.

1. JP teaches that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in, see abstract.

Thus it would have been obvious to extract *Cercis chinensis* with ethanol since Ma makes it clear that the plant is commonly extracted with 95 % ethanol. Further it is obvious to use tablet or powder form instead of liquid form of CN since JP makes it clear that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the ethanol to use) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

It is respectfully suggested that this rejection is virtually identical to that immediately preceding it. For that reasons, it is further suggested that the foregoing remarks are sufficient to traverse this rejection as the citations are identical.

#### CONCLUSION

This response is being filed within the shortened period for response. No further fee is believed to be due. If, on the other hand, it is determined that any further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to deposit account 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

In view of the actions taken and arguments presented, it is respectfully submitted that each of the matters raised by the Examiner has been addressed by the present amendment and that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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